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**RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 3622**

PATENT
Customer No. 22,852
Attorney Docket No. 08011.3010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
John DeMayo et al.) Group Art Unit: 3622
Application No.: 09/711,261) Examiner: Donald Champagne
Filed: November 10, 2000)
For: APPARATUS AND METHOD FOR) Confirmation No.: 6688
HYPERLINKING SPECIFIC)
WORDS IN CONTENT TO TURN)
THE WORDS INTO)
ADVERTISEMENTS) **Mail Stop AF**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR RECONSIDERATION

In reply to the Final Office Action mailed August 2, 2004, the period for reply extending through November 2, 2004, and pursuant to 37 C.F.R. § 1.116, Applicants respectfully request reconsideration in light of the following remarks.

Claims 1-30 are pending in this application. In the Final Office Action, the Examiner rejected claims 1-2, 4-6, 9-10, 12-13, 21, and 24 under 35 U.S.C. § 102(e) as anticipated by Bull et al. (U.S. Patent No. 5,995,943); rejected claims 3, 7, 11, 14-15, 22, and 25 under 35 U.S.C. § 103(a) as obvious over Bull; rejected claims 8, 16, 23, and 26 under 35 U.S.C. § 103(a) as obvious over Bull in view of Portuesi; rejected

claims 17-19 and 27-29 under 35 U.S.C. § 103(a) as obvious over Bull in view of Murray (U.S. Patent No. 6,061,659); and rejected claims 20 and 30 under 35 U.S.C. § 103(a) as obvious over Bull in view of Murray and further in view of Portuesi (U.S. Patent No. 5,774,666).

Applicants respectfully traverse the rejection of claims 1-2, 4-6, 9-10, 12-13, 21, and 24 under 35 U.S.C. § 102(e) as anticipated by Bull. To properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” See M.P.E.P. § 2121 (8th ed., Aug. 2001), quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

Claim 1 recites an “apparatus for hyperlinking specific words in content to turn the words into advertisements” including, among other things, “an ad server connected to the Internet, wherein the ad server provides means for providing a hypertext anchor to an advertiser-chosen word or phrase in a content file to link said advertiser-chosen word or phrase to said advertiser web page.” Bull does not disclose at least these features.

Instead, in Bull, “ads/coupons are inserted alongside displayed data (text, picture or index displays....” See col. 9, lines 37-39. Inserting an ad into an existing web page, as taught by the reference, does not constitute “link[ing] a word or phrase to said advertiser's web page,” as recited in claim 1. The Bull system, consequentially,

includes links that are part of the ads/coupons that are inserted alongside displayed data. This, however, does not constitute Applicants' claimed "apparatus for hyperlinking specific words in content to turn the words into advertisements." In other words, Bull places an ad along with displayed data, i.e., the ad is in addition to existing content. It does not, however, provide "a hypertext anchor to an advertiser-chosen word or phrase in a content file to link said advertiser-chosen word or phrase to said advertiser web page," as recited in claim 1.

Bull also teaches that "advertisers can input World Wide Web (WWW) referential information (hot links) to be displayed with ads/coupons or on geographic map displays." See col. 8, lines 19-21. Hot links, however, are clearly not part of a content file, as recited in claim 1. Instead, hot links are displayed with ads/coupons, which, as the reference states repeatedly, "are inserted *alongside* displayed data (text, picture or index displays)...." See col. 9, lines 37-39 (emphasis added); col. 5, lines 19-20. This, however, does not constitute providing "a hypertext anchor to an advertiser-chosen word or phrase in a content file to link said advertiser-chosen word or phrase to said advertiser web page," as recited in claim 1.

Additionally, the Examiner alleges that "it is the ad end of the hyperlink which is provided by advertisers." See Final Office Action, page 3. Applicants respectfully disagree with the Examiner's characterization. In Bull, it is the ads/coupons that are displayed in addition to the existing content. However, this does not constitute providing "a hypertext anchor to an advertiser-chosen word or phrase in a content file to link said advertiser-chosen word or phrase to said advertiser web page," as recited in claim 1.

The Examiner further alleges that “there is no claim limitation as to the size and placement of the ads in the display.” Id. Applicants disagree with the relevance of the Examiner’s statement and point out that claim 1 indicates the placement of the ads, namely, that “an advertiser-chosen word or phrase in a content file [is linked] to said advertiser web page.” At least this feature is not disclosed by Bull.

In addition, the Examiner concludes “it is immaterial whether the reference teaches that ads are displayed alongside content” for this reason. Id. Applicants again disagree and take this opportunity to clarify that accordingly to Applicants’ claimed invention, “specific words in content [are hyperlinked] to turn the words into advertisements.” Bull, however, does not teach at least this feature. Instead, Bull discloses inserting ads/coupons as indicated by the discussion of the ad/coupon insertion system 296 that “determines which ads should be placed (or rotated) and makes the placement (or establishes the rotation).” See col. 13, lines 55-58. According, in Bull, ads are added alongside displayed data. This, however, does not constitute at least providing “a hypertext anchor to an advertiser-chosen word or phrase in a content file to link said advertiser-chosen word or phrase to said advertiser web page,” as recited in claim 1.

Because Bull does not teach all of the elements of claim 1, Applicants respectfully request the reconsideration and withdrawal of the section 102(e) rejection of claim 1, and claims 2 and 4-6, which depend therefrom.

Independent claims 9, 21, and 24 were rejected using similar reasoning by the Examiner. These claims, while of a different scope, include recitations similar to allowable claim 1. Accordingly, the Examiner should withdraw the rejection of claims 9,

21, and 24 for at least the same reasons. Dependent claims 10 and 12-13, which depend from allowable independent claim 9, are thus also allowable.

Applicants respectfully traverse the rejection of claims 3, 7, 11, 14-15, 22, and 25 under 35 U.S.C. § 103(a) as obvious over Bull. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Claims 3 and 7 depend from claim 1, claims 11-15 depend from claim 9, claim 22 depends from claim 21, and claim 25 depends from claim 24. As discussed above, Bull does not teach every element of independent claims 1, 9, 21, and 24. For example, Bull does not teach at least "an ad server connected to the Internet, wherein the ad server provides means for providing a hypertext anchor to an advertiser-chosen word or phrase in a content file to link said advertiser-chosen word or phrase to said advertiser web page," as recited in claim 1, for example. Further, nothing in Bull suggests this claim element and the Examiner does not allege any suggestion of it. Instead, Bull

makes clear that its hot links do not modify existing content, but are instead inserted alongside displayed data.

In making the rejection, the Examiner admits that Bull does not teach “using a script to provide a hypertext anchor” and “using frames to display the content provider URL in a browser window.” See Final Office Action, page 3. The Examiner further alleges using a script to overwrite existing HTML of a content file “is inherent whenever adding an anchor to an existing content file.” See id. at page 4. Then Examiner then takes Official Notice that such features are “common and well known practices.” See id. at pages 3-4.

Applicants again take issue with the Examiner’s taking of Official Notice, as well as the unsupported allegations made in paragraph 11. Applicants respectfully refer the Examiner to the February 21, 2002 Memorandum from USPTO Deputy Commissioner for Patent Examination Policy, Stephen G. Kunin, regarding “Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice.” In relevant part, the Memorandum states, “If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding” (Memorandum, p. 3). Applicants submit that the Examiner has made a generalized statement regarding Applicants’ claims without any documentary evidence to support it.

Applicants traverse the Examiner’s presumed taking of “Official Notice,” noting the impropriety of this action, as the Federal Circuit has “criticized the USPTO’s reliance on ‘basic knowledge’ or ‘common sense’ to support an obviousness rejection, where

there was no evidentiary support in the record for such a finding.” *Id.* at 1. Applicants submit that “[d]eficiencies of the cited references cannot be remedied by … general conclusions about what is “ basic knowledge” or “common sense.”” In re Lee, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Should the Examiner maintain the rejection after considering the arguments presented herein, Applicants submit that the Examiner must provide “the explicit basis on which the examiner regards the matter as subject to official notice and allow Applicants to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made” (*Id.* at 3, emphasis in original), or else withdraw the rejection. For at least these reasons, the Examiner should withdraw the rejection of claims 3, 7, 11, 14-15, 22, and 25 under 35 U.S.C. § 103(a).

Applicants respectfully traverse the rejection of claims 8, 16, 23, and 26 under 35 U.S.C. § 103(a) as obvious over Bull in view of Portuesi. Claim 8 depends from claim 1, claim 16 depends from claim 9, claim 23 depend from claim 21, and claim 26 depends from claim 24. As discussed above, Bull fails to teach or suggest every element of claims 1, 9, 21, and 24 and their dependent claims. Furthermore, Portuesi does not cure this defect. Portuesi disclose a system that adds a Uniform Resource Location (URL) track into a movie file in addition to audio and video tracks. See col. 4, line 63 to col. 5, line 5. Nothing in the reference discloses or suggests at least “an ad server connected to the Internet, wherein the ad server provides means for providing a hypertext anchor to an advertiser-chosen word or phrase in a content file to link said

advertiser-chosen word or phrase to said advertiser web page,” as recited in claim 1, for example.

Additionally, claims 8, 16, 23, and 26 recite linking to an advertiser web page using a tracking URL. This claim element is not taught or suggested by Bull or Portuesi. Regarding this claim element, the Examiner pointed to a teaching in Portuesi of a movie file with a plurality of tracks, including an audio track, an image track, and a URL track. Portuesi, col. 4, lines 63-65. The multiple tracks of a movie file are unrelated to linking to a web page using a tracking URL, as recited in claims 8, 16, 23, and 26. Consequentially, the teachings of Portuesi do not constitute a “tracking URL” as recited in Applicants’ claims.

Furthermore, the Examiner alleges that one of ordinary skill in the art would have been motivated to combine Portuesi with Bull because it allegedly teaches “linking to a time-based medium.” See Final Office Action, page 4. Instead, however, Portuesi teaches away from Applicants’ claimed invention. Portuesi uses a time-based medium, such as a movie file, embedded with a URL in a track of the movie file. This URL is used to activate the URL during display of the movie. See Abstract. However, this has nothing to do with Applicants’ claimed “tracking URL.” Applicants note that a “tracking URL” is discussed in the specification at least at page 5, lines 17-22, for example.

In referring to the specification herein, it is to be understood that Applicants are in no way intending to limit the scope of the claims to the exemplary embodiments shown in the drawings and described in the specification. Rather, Applicants expressly affirm that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation and applicable case law.

For at least these reasons, the references fail to teach or suggest all elements of claims 8, 16, 23, and 26. Applicants therefore request the reconsideration and withdrawal of the section 103 rejections of these claims.

Applicants respectfully traverse the rejection of claims 17-19 and 27-29 under 35 U.S.C. § 103(a) as obvious over Bull in view of Murray. Claim 17 recites, among other things, “altering the HTML coding of content for an Internet-displayed file to include a hypertext anchor on an advertiser-chosen word or phrase to link to an advertiser web page.” Claim 27 recites, among other things, “altering the document file with software to include a hypertext anchor on an advertiser-chosen word or phrase to link to an advertiser document.” As discussed above, Bull does not disclose or suggest at least these features.

Furthermore, Murray does not make up for the deficiencies of Bull. Murray merely discloses a system that uses HTML documents to provide content through a browser using pre-defined HTML tags. See col. 5, lines 14-16; col. 6, lines 32-39. Nothing in the reference suggests altering the HTML coding to include a hypertext anchor on an advertiser-chosen word or phrase to link an advertiser web page. Accordingly, Murray does not disclose or suggest all elements of claims 17 and 27. Dependent claims 18-19 and 28-29 depend from allowable independent claims 17 and 27 and are allowable at least due to their dependence from allowable claims.

In addition, Applicants respectfully traverse the Examiner’s taking of Official Notice with respect to claims 19 and 29 for the reasons discussed above. Should the Examiner maintain the rejection after considering the arguments presented herein, Applicants submit that the Examiner must provide “the explicit basis on which the

examiner regards the matter as subject to official notice and allow Applicants to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made" (*Id.* at 3, emphasis in original), or else withdraw the rejection.

Applicants respectfully traverse the rejection of claims 20 and 30 under 35 U.S.C. § 103(a) as obvious over Bull in view of Murray and further in view of Portuesi.

Claims 20 and 30 depend from allowable claims 17 and 27. As discussed above, Bull and Murray do not disclose or suggest all of the features of claims 17 and 27. Portuesi does not make up for the deficiencies of Bull and Murray. Furthermore, in rejecting claims 20 and 30 the Examiner has again alleged that Portuesi teaches Applicants' claimed "tracking URL." See Final Office Action, page 5. Applicant disagrees for at least the reasons provided above, and again submits that Portuesi's use of a time-based medium, such as a movie file, embedded with a URL in a track of the movie file, does not constitute Applicants' claimed "tracking URL." Accordingly, the Examiner should withdraw the rejection and allow claims 20 and 30.

CONCLUSION

Applicants respectfully requests that the Examiner consider this response 37 C.F.R. § 1.116, placing the pending claims in condition for allowance. In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

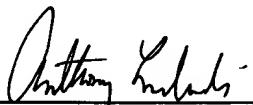
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 1, 2004

By:



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